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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,638	08/29/2001	Takahiro Nakayama	500.40580X00	5603

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EXAMINER

HOGANS, DAVID L

ART UNIT	PAPER NUMBER
	2813

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/940,638	NAKAYAMA ET AL.
	Examiner David L. Hogans	Art Unit 2813

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 August 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-6 and 8-12 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3-6 and 8-12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 29 August 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

This Office Action is in response to Amendment B filed on August 4, 2003.

### ***Status of Claims***

Claims 1, 3-6 and 8-10 are pending. Claims 11-12 are newly added.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 3-6 and 8-12 are rejected under 35 U.S.C. 102(e) as being anticipated by 6,310,360 to Forrest et al.

In reference to Claims 1, 3, 6, 8, 11 and 12, Forrest et al. teaches:

- an electroluminescent film device with a light-emitting layer where an excited state generated by electron hole recombination is utilized for photon generation  
(See columns 9-19 lines 01-20)
- a light-emitting layer containing a material in which the quantum number of orbital angular momentum and the quantum number of excited state spin are convertible into each other by their interaction and wherein the material is a molecule in which a heavy metal atom is bonded to or coordinated to an organic material (Ir(ppy)<sub>3</sub>); and (See column 9 lines 17-65 and columns 12-15 lines 59-20 and Figure 1)

- a light-emitting molecule (DCM2), each as an independent dopant (See column 9 lines 17-65 and columns 12-15 lines 59-20 and Figure 1)

The Examiner notes that the limitation wherein the light-emitting layer is an organic film formed by simultaneous vapor deposition, in Claims 6, 11 and 12, is a processing limitation and, therefore, carries no weight in a claim drawn to a device.

"Even though product -by[-] process claims are limited by and defined by the process, determination of patentability is based upon the product itself. The patentability of a product does not depend on its method of production. If the product in product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product is made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985)(citations omitted).

A "product by process" claim is directed to the product per se, no matter how actually made, *In re Hirao and Sato et al.*, 190 USPQ 15 at 17 (CCPA 1976) (footnote 3). See also *In re Brown and Saffer*, 173 USPQ 685 (CCPA 1972); *In re Luck and Gainer*, 177 USPQ 523 (CCPA 1973); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); and *In re Marosi et al.*, 218 USPQ 289 (CAFC 1983) final product per se which must be determined in a "product by, all of" claim, and not the patentability of the process, and that an old or obvious product, whether claimed in "product by process" claims or not.

Note that Applicant has the burden of proof in such cases, as the above caselaw makes clear.

In reference to Claims 4, 5, 9 and 10, Forrest et al. teaches:

- incorporating all arguments of Claims 1 and 6 and noting that Forrest et al. teaches wherein the light-emitting molecule (PtOEP) is a molecule in which a heavy metal atom (Pt) is bonded or coordinated to an organic material (See column 15 lines 25-60)

The Examiner notes that column 15 lines 25-60 teaches a intersystem crossing agent (ISC) comprised by benzil or other ISC agents. The Examiner also notes that column 9 lines 17-36 teaches that ISC agents may be comprised by  $\text{Ir}(\text{ppy})_3$  or other metals of the third row of the periodic table coupled to organometallic compounds.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 3-6 and 8-10 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Hogans whose telephone number is (703) 305-3361. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead Jr. can be reached on (703) 308-4940. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

dh  
September 4, 2003

*Carl Whitehead*  
CARL WHITEHEAD, JR.  
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